



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,501	08/01/2001	Hubert Helaine	Q65593	3234

7590 03/22/2004

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
Suite 800
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

TORRES, MARCOS L

ART UNIT	PAPER NUMBER
2683	4

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,501

Applicant(s)

HELAINE ET AL.

Examiner

Marcos L Torres

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3 12-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sipilä.

As to claims 1, 15 and 16, Sipilä discloses an automatic network services management method (see col. 1, lines 3-10) in which: a communication terminal of a first network is connected to a private base (see col. 1, lines 50-51), said private base is connected to a second network (see col. 1, lines 51-54), to establish a correspondence between said first network and service codes of said second network (see col. 2, lines 3-11; col. 9, lines 45-52). Sipilä does not specifically disclose a memory with service codes. Buhrmann discloses a memory with service codes (see col. 9, lines 1-29). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine both teachings for enhanced compatibility.

As to claim 3, Sipilä discloses the method wherein said correspondence memory is in said private base (see col. 2, lines 3-11; col. 9, lines 45-52).

As to claims 12 and 13, Sipilä discloses the method wherein said first network is a mobile telephone network and second network is a terrestrial telephone network (see col. 1, lines 50-54).

5. Claims 2, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sipilä in view of Buhrmann as applied to claims 1, 3 12-13 and 15-16 above, and further in view of Kasmperschroer.

As to claim 2, Sipilä discloses the method of using a correspondence memory (see col. 2, lines 3-11; col. 9, lines 45-52) Sipilä does not specifically disclose wherein said correspondence memory is in said communication terminal. Kasmperschroer discloses wherein said correspondence memory is in said communication terminal (see col. 10, lines 53-57). Therefore, it would have been obvious to one of the

ordinary skill in the art at the time of the invention to add this teaching to the Sipilä method for a reliable registration.

As to claims 4 and 8, Sipilä discloses the method wherein: a request corresponding to a service is composed from said communication terminal (see col. 9, lines 1-3), said request is sent from said communication terminal and received at said private base (see col. 9, lines 13-15), and said request is updated in said private base as a function of said correspondence memory (see col. 9, line 26 - col. 10, line 3). Sipilä does not specifically disclose said request is sent to said second network and is received by an operator managing said services of said second network.

Kasmperschroer disclose said request is sent to said second network and is received by an operator managing said services of said second network (see col. 7, lines 6-24).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Sipilä method to ensure compatibility in the connection.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sipilä in view of Buhrmann and further in view of Kasmperschroer as applied to claims 2, 4 and 8 above, and further in view of Vanden Heuvel.

As to claim 5, Sipilä discloses the method wherein, if said correspondence data contains no match to said request sent by said communication terminal send an error message (see col. 9, lines 13-17). Kasmperschroer disclose said request is sent to said second network and is received by an operator managing said services of said second network (see col. 7, lines 6-24). Sipilä and Kasmperschroer do not specifically disclose

Art Unit: 2683

transmitting without changing the format. Vanden Heuvel disclose transmitting without changing the format (see col. 10, lines 16-21). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the modified Sipilä and Kasmperschroer method for the simple purpose of compatibility.

7. Claims 6-7, 9-11 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Sipilä in view of Buhrmann and further in view of Kasmperschroer as applied to claims 2, 4 and 8 above, and further in view of Foladare.

As to claim 11, Sipilä and Kasmperschroer disclose everything claimed as explained above except for the method wherein said updating is triggered by a user. Foladare discloses the method wherein said updating is triggered by a user (see col. 4, lines 35-37). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique in the modified Sipilä and Kasmperschroer method for enhanced control and versatility to the user.

As to claims 6 and 7, Kasmperschroer disclose processing of said request by an operator managing said services of said second network (see col. 7, lines 6-24). Kasmperschroer does not specifically disclose the method wherein an acknowledgement is received at said communication terminal or private base. However, OFFICIAL NOTICE IS TAKEN THAT the technique of receiving an acknowledgement is a common and well-known technique. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple purpose of confirms the delivery of data.

As to claims 9 and 10, Sipilä does not specifically disclose the method wherein said correspondence memory is updated automatically and periodically. However, OFFICIAL NOTICE IS TAKEN THAT the technique of updating memory automatically and periodically it is a common and well-known technique. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple reason of refresh the memory cycle and preserve the data.

As to claim 14, Sipilä does not specifically disclose the method wherein said mobile communication terminal is automatically connected to said private base when said terminal is within range of said base. However, OFFICIAL NOTICE IS TAKEN THAT the method of automatically connect or activate device when is within range is a common and well-known method. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the Sipilä method for user convenience.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Cyr U.S. Patent US005890075A
- b. Khan U.S. Patent US005926760A
- c. Jeon U.S. Patent US006205331B1
- d. Chang U.S. Patent US006529491B1
- e. Amin U.S. Patent US006630883B1

Art Unit: 2683

Any response to this Office Action should be mailed to:

Commissioner of Patent and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 703-872-9314

For formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Crystal Park II
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L Torres whose telephone number is 703-305-1478. The examiner can normally be reached on 8:00am-5:30pm alt. Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marcos L Torres
Examiner
Art Unit 2683

Mlt



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600